

REMARKS

Claims 1-2 and 4-12 are pending in this application after this Amendment. Claims 1 and 8 are independent. In light of the amendments and remarks contained herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

By this Amendment, Applicant has amended claims 1 and 8 to more appropriately recite the present invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected claims 1-12 under 35 USC §103(a) as being unpatentable over *Murat* (GB 2 327 572) in view of *Chao-Cheng* (USP 5,991,643). Applicant respectfully traverses this rejection.

**Claim Rejections - 35 U.S.C. § 103**

By this Amendment, Applicant has amended claim 1 to recite, *inter alia*, a mobile communications device comprising a control switch for controlling the switch, wherein the control circuit controls the switch based upon a selection of one of a plurality of modes including a first mode for connecting the directional antenna to the transmitter/receiver section if voice communication is being performed, a second mode for connecting the non-directional antenna to the transmitter/receiver section regardless of whether voice

communication is being performed, and a third mode for connecting the directional antenna to the transmitter/receiver section regardless of whether voice communication is being performed.

It is respectfully submitted that neither of these references, either alone or in combination, assuming these references are combinable, which Applicant does not admit, teach or suggest this claim element. As can be seen in Fig. 2 of the *Murat* reference, the telephone merely incorporates a switch that engages either the directional antenna or the non-directional antenna. There is no disclosure in *Murat* that is directed to a plurality of modes.

The disclosure of *Chao-Cheng* is directed to a radio receiver having switchable antennas. A mode control circuit controls resistor switches so that the impedance of the impedance matching circuit can match the impedance of the connected antennas. In each control mode, each antenna switch and the corresponding resistor switch will be opened or closed at the same time so that the impedance of the impedance matching circuit can match the impedance of the connected antennas. However, there is no teaching or suggestion in *Chao-Cheng* that is directed to a first, second, and third mode as recited in claim 1 as amended.

As neither of the references, either alone or in combination, teach or suggest all of the claim elements as set forth in claim 1, as amended, it is respectfully submitted that claim 1, as amended, is allowable over the references as cited by the Examiner.

It is respectfully submitted that claims 2, 4-7, and 9-12 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

With regard to the Examiner's rejection of claim 8, the Examiner admits that neither of the references teach a touch sensor wherein the switch connects to a directional antenna when the touch sensor is sensing touch and connects to a non-directional antenna when the touch sensor is not sensing touch. The Examiner concludes that as *Murat* teaches a proximity sensor, it would have been obvious to one of ordinary skill in the art to have included a loud speaker in order to allow a user to conduct voice communication and a touch sensor for the advantage of expanding the capability of the communication device to various types of sensors in order to switch the device to a directional or a non-directional antenna effectively. Applicant respectfully disagrees with these assertions.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of

success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner admits that neither of the references teach or suggest the touch sensor wherein when the touch sensor is sensing touch, the switch connects the directional antenna to the transmitter/receiver section and when the touch sensor is not sensing touch, the switch connects the non-directional antenna to the transmitter/receiver section. The Examiner fails to provide a reference that teaches or suggests this claim element. As the Examiner has failed to provide references that teach or suggest all of the elements as set forth in claim 8, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness. For at least this reason, it is respectfully requested that the outstanding rejection be withdrawn.

If the Examiner is taking Official Notice with regard to the teaching of a touch sensor, Applicant respectfully traverses this Official Notice and respectfully requests that the Examiner provide a properly combinable reference that teaches or suggests the touch sensor element as recited in claim 8.

In addition, it is respectfully submitted that the Examiner has failed to provide proper motivation to combine the teachings of the references. The Examiner concludes that it would have been obvious to have included a touch sensor in order to expand the

capability of a communication device to various types of sensors in order to switch the device to a directional or non-directional antenna effectively. However, as there is no teaching of a touch sensor in either of the references, it appears that the Examiner has utilized his motivation from the Applicant's specification. It is respectfully submitted that this amounts to improper hindsight. As the Examiner has provided improper motivation for the combination of these references, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness. As such, it is respectfully requested that the outstanding rejection be withdrawn.

#### **Additional Remarks**

On February 26, 2002, Applicant filed an Information Disclosure Statement concurrently with the filing of the present patent application. To date, Applicant has not received a signed copy of the Form PTO-1449. Applicant respectfully requests consideration of the document contained in the Information Disclosure Statement.

#### **Conclusion**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview

in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  *Corneille M. Vorinés*  
#52,327

Charles Gorenstein, #29,271

CG/CMV/jdm  
2936-0149P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000

(Rev. 02/12/2004)